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Paper No. 7

MEDTRONIC, INC.
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MS-LC340
MINNEAPOLIS MN 55432-5604

COPY MAILED

AUG 16 2002

In re Application of
Stein, et al.
Application No.: 10/040,143
Filed: January 3, 2002
Attorney Docket No.: P-9484.01
For: MEDICAL LEAD AND LEAD
CONNECTOR SYSTEM

OFFICE OF PETITIONS
DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed May 9, 2002.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on January 3, 2002 without an executed oath or declaration. Accordingly, on February 1, 2002, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration, substitute drawings, and a surcharge for the late filing of the oath or declaration.

In response, on May 9, 2002 (certificate of mailing date May 1, 2002), a petition for a one month extension of time and required fee, substitute drawings, a declaration executed by some of the joint inventors, the surcharge, the petition fee, and the instant petition were filed. A declaration of facts of Girma Wolde-Michael is part of the petition. Ms. Wolde-Michael states that Paul M. Stein, Timothy W. Holleman, Andrew J. Ries, Harry Schroder, Jordon D. Honeck, John L. Sommer, and Vicki L. Bjorklund are co-inventors of the above-identified patent application.

However, a review of the declaration reveals that there are two additional inventors listed: Douglas S. Hine and Robert S.(?) Schwartz. Both of these names have been crossed off the executed declaration. Messrs. Ries, Honeck, Sommer, and Bjorklund signed the declaration with Mr. Schwartz, not Mr. Schroder, listed as an inventor. In addition, Mr. Hine signed the declaration, but his information was subsequently crossed out by an unnamed party.

The names listed on the declaration fix the inventive entity. The inventive entity includes those persons listed by Ms. Wolde-Michael AND Messrs. Hine and Schwartz.

It is unclear as to what petitioners are requesting with respect to Mr. Hine. Paragraph 5 of the petition states that Mr. Hine is not truly an inventor and requests that the Office remove him from the application. Paragraph 7 of the petition states that Mr. Hine is not cooperating with signing the Combined Declaration/Power of Attorney papers and that Medtronic, Inc. would like agency for Mr. Hine. If petitioners wish to remove Mr. Hine, petitioners should file a petition under 37 CFR 1.48 or file a continuing application that names the correct inventors. If petitioners wish to include Mr. Hine as an inventor, petitioners should proceed under 37 CFR 1.47 (unavailable

inventor who refuses to sign the declaration or cannot be located).

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition with respect to Mr. Hine lacks items (1) and (2) above.

As to item (1), Applicants have failed to establish that the inventor has refused to sign the declaration or cannot be found. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events. The Office requires that the non-signing inventor be provided with a complete copy of the application as filed. This includes the specification with claims, drawings, if any, and a declaration. See MPEP 409.03(d). If Mr. Hine refuses to sign the declaration within a reasonable amount of time, petitioners will have shown refusal. In the alternative, if Mr. Hine cannot be found after diligent efforts, then petitioners will have satisfied this requirement.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The declaration contains an noninitialed, nondated alterations. 37 CFR 1.52(c) states that “[a]ny interlineation, erasure, cancellation or other alteration of the application papers filed should be made on or before the signing of the accompanying oath or declaration pursuant to 1.63....” This includes the oath or declaration. The Office will not consider whether noninitialed and or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration. See MPEP 605.04(a). An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicants on behalf of the non-signing inventor(s) is REQUIRED. See MPEP 409.03(a).

Pursuant to petitioners' authorization, deposit account no. 13-2546 will be charged the \$130.00 fee associated with filing this type of petition.

Removing Mr. Schwartz from the inventive entity would require a petition under 37 CFR 1.48. Another option would be to file a continuing application that names the correct inventors.

Because the declaration submitted May 9, 2002 (certificate of mailing date May 1, 2002) is not acceptable, the associate power of attorney filed on the same date cannot be made of record. Once an acceptable declaration is filed, assuming Attorney Wolde-Michael is of record, Michael C. Soldner will be recorded as an associate attorney.

The substitute drawings filed May 9, 2002 (certificate of mailing date May 1, 2002) are not usable due to the irradiation process used by the Office in response to the anthrax scare. Petitioners are requested to send another copy of the substitute drawings within two months of the mail date of this decision.

The address listed on the petition differs from the address listed on the application transmittal letter. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record as stated on the application transmittal letter.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By facsimile: (703) 308-6916
 Attn: Office of Petitions

By hand: Office of Petitions
 2201 South Clark Place
 Crystal Plaza 4, Suite 3C23
 Arlington, VA 22202

Telephone inquiries should be directed to the undersigned at (703) 308-6712.



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